

# BEYER WEAVER & THOMAS, LLP

## INTELLECTUAL PROPERTY LAW

590 W. El Camino Real, Mountain View, CA 94040  
Telephone: (650) 961-8300 Facsimile: (650) 961-8301  
www.beyerlaw.com

July 13, 2000

### VIA CERTIFIED MAIL WITH RETURN RECEIPT

Mr. Nathan Williams  
1401 University St.  
Helena, MT 59601-6061

Re: U.S. Patent Application Entitled: METHOD AND APPARATUS FOR UPDATING  
INFORMATION IN A LOW-BANDWIDTH CLIENT/SERVER OBJECT-ORIENTED  
SYSTEM

Inventors: Arnold et al.

Application No. 09/518,753

Our File: SRI1P013X1

Filed: March 3, 2000

Your File: P-3879

Dear Mr. Williams:

This is to follow up on our telephone conversation of July 11, 2000, concerning the Continuation-In-Part patent application that we prepared for the InCon technology. In our telephone conversation, you indicated that that you believe that you were integrally involved with the development of the concepts described and claimed in the patent application. It is my understanding from our telephone conversation that you do not intend to sign the declaration associated with the application due to an apparent dispute you had with SRI International. I also understand that your preference is that SRI International not be able to obtain a patent on the InCon technology, so that you and/or others would be free to apply concepts associated with the InCon technology in the future.

As I indicated to you in our telephone conversation, we are enclosing a copy of the CIP patent application that we have prepared for your review. As you can see, the application lists five inventors of the subject matter, namely James Arnold, Scott Seaton, Carla Woodworth, Michael Fransen, and yourself. If by chance you have reconsidered your intention not to sign the declaration, I would ask that you review the application and execute the enclosed declaration, assuming that the application is in good order. I am enclosing a guide which I believe may facilitate your review of the application. If you have any comments or corrections concerning the application, we would greatly appreciate it if you could provide us with those comments.

After you have reviewed the application, and executed the declaration, we would also ask that you execute the enclosed assignment of the application to SRI International. I understand that you have outstanding issues with SRI International and would prefer not to execute the assignment at this time. If that is the case, I would hope that you would at least consider

executing the declaration, since we understand that you were a key contributor to the concepts claimed in this application.

We would also remind you that we have a duty to disclose the most pertinent prior art which we are aware of to the Patent Office. If you know of any references that are relevant to the Patent ability of the enclosed application, I would ask that you enclose those as well. We would greatly appreciate it if you would review the enclosed application, and execute the enclosed declaration and assignment, and return the same to our office by July 25, 2000.

We look forward to receiving the executed formal papers in the near future.

Best regards,

BEYER WEAVER & THOMAS, LLP

  
Steve D Beyer

Enclosures

## GUIDE TO REVIEW OF YOUR APPLICATION

Your review of this patent application should not be limited to ensuring that the description is correct from a technical point of view. There are several issues you must consider so that we can be certain a valid patent will ultimately be obtained. The important questions you should consider are listed below.

1. You have an obligation to disclose the best way of making and using your invention in the application. Are you aware of anything that could make your invention "better" which we have not disclosed?
2. Who contributed to conception of the claimed ideas? If we have not included an inventor, please add their name, etc. On the other hand, be sure we have not listed anyone who did not contribute to conception of the ideas recited in the claims. If you have any questions about who should be properly named, we should discuss this issue.
3. Could someone readily make and use the invention based only upon the patent application? If not, we should include further technical details about your invention.
4. Do the broad claims (especially claim 1) have any unnecessary limitations, i.e., could someone use your invention without using an element of the claims? On the other hand, does claim 1 include at least one element which was not found in previous devices/methods?
5. What related patents, papers, and other public materials are you and the other inventors aware of. Failure to disclose pertinent prior art to the Examiner could invalidate the entire patent. Note that you will have a continuing obligation to bring pertinent prior art to the Examiner's attention even after we file the application. Please note further that we have drafted the claims broadly based on the prior art of which we are aware. Consider whether you are aware of additional art which is pertinent in view of the breadth of the claims. If you do not understand the scope of the claims clearly, please contact us and we will be glad to discuss this issue further.
6. Has there arguably been any non-experimental disclosure or use of the invention, or any offer for sale of the invention more than one year ago? If so, it will be necessary to bring this to the Examiner's attention.
7. Were any of the claimed ideas developed while working on a government contract? If so, we will need to disclose this information.

## WHO IS AN INVENTOR?

A patent application contains a detailed description (text and drawings) of the preferred design of the product which is the subject of the invention. In a corporate engineering environment, there will be dozens and perhaps hundreds of individuals who will have some input into the design which is described in the patent application.

Following the detailed description in the application are a number of claims, which define the invention which is to be protected by the patent. It is these claims which have legal significance -- the detailed description merely sets the stage for the claims.

An individual is an inventor if he or she made a material contribution to what is set forth as the invention in one or more of the claims. It is very helpful to have such contributions documented and dated. The fact that an individual may have made a contribution to the design set forth in the detailed description does not constitute inventorship if that particular aspect of the design is not specifically set forth in the claims.

An individual is an inventor if that individual originally suggests an item claimed. Other types of contributions, such as suggesting that a prior concept is unworkable, promoting the original thought of another, or modifying the original thought of another in a manner not claimed as invention, may be valuable engineering contribution, and perhaps even more valuable than originating the concept, but it is only the originator of a concept claimed who is specified as an inventor.

Many inventions are the joint inventions of two or more inventors. Each person named as an inventor in a joint patent application need not have contributed something to each claim. Under certain circumstances we will need to know who the inventors are on a claim-by-claim basis. Therefore, as you read over the application and claims, please note directly on the draft copy of the application (or on a separate piece of paper), the name(s) of the inventor(s) for each claim and send the list to us for our files.